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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,850	02/13/2002	Jerry Douglas Young	8419M	6339

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EXAMINER	
WEIER, ANTHONY J	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/074,850	YOUNG ET AL.	
	Examiner	Art Unit	
	Anthony Weier	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. In view of Applicants' arguments filed 5/24/04, the Restriction Requirement has been withdrawn and all of the pending claims have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8, 10-14, 16, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by any one of German 3710768, JP 11-32680, and JP 3-133368.

Any one of German 3710768, JP 11-32680, and JP 3-133368 discloses a coffee composition having a coffee source that is roasted and ground in both JP 11-32680 and JP 3-133368. In German 3710768, a coffee extract is produced from roasted coffee which would inherently be ground to effect the vehicle needed for extraction. In addition, any one of German 3710768, JP 11-32680, and JP 3-133368 further discloses a coffee source component modifier (by way of acid), and a supplemental coffee source component (JP 11032680, e.g. sodium; JP 133368, e.g. calcium; German

3710768, e.g. page 6, calcium). Each of said references discloses the preparation or suggests the intent of preparing a coffee extract and beverage (i.e. ready to drink product) using such composition. It is considered inherent that said coffee produced would be a desired coffee and that same meets said desired coffee as a target coffee. Furthermore, once the desired coffee has been produced it is inherently within the pH range and compositional percentages intended for such desired coffee and, therefore, the target coffee.

3. Claims 1-5, 7, 10-13, 15, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Bach et al.

Bach et al (e.g. col. 11, lines 38-62) discloses a coffee composition having a coffee source that is roasted and ground, a coffee source component modifier (by way of acid), and a supplemental coffee source component (e.g. calcium) wherein said composition is later treated to prepare a soluble coffee product (e.g. col. 12, lines 29-36) to be used in preparing a coffee beverage (i.e. ready to drink product). It is considered inherent that said coffee produced would be a desired coffee and that same meets said desired coffee as a target coffee. Furthermore, once the desired coffee has been produced it is within the pH range and compositional percentages intended for such desired coffee and, therefore, the target coffee.

4. Claims 1-5, 7, 10-13, 15, 18, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by any one of Zeller et al ('131), Atkinson et al ('203), and Villiagran et al ('567).

Any one of Zeller et al ('131), Atkinson et al ('203), and Villiagran et al ('567) discloses a coffee composition comprising a coffee source, a coffee source component modifier (by way of acid), and a supplemental coffee source component (Villiagran et al, e.g. col. 5, lines 48-65; Atkinson et al, e.g. Examples; Zeller et al, e.g. col. 4, lines 12-18) and wherein said composition is then treated to prepare a soluble coffee product and beverage (i.e. ready to drink product). It is considered inherent that said coffee produced would be a desired coffee and that same meets said desired coffee as a target coffee. Furthermore, once the desired coffee has been produced it is within the pH range and compositional percentages intended for such desired coffee and, therefore, the target coffee.

5. Claims 1-5, 8, 10-13, 16, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Lendrich et al.

Lendrich et al discloses a coffee composition having a coffee source, a coffee source component modifier (by way of acid), and a supplemental coffee source component (page 2, lines 81-96). Although Lendrich et al does not specifically articulate a ready to drink coffee or extract of coffee, same is suggested by the uses of said coffee (e.g. a drink) and the intended solution driving the invention (e.g. see page 1, lines 16-33). It is considered inherent that said coffee produced would be a coffee desired by Lendrich et al and that same meets said desired coffee as a target coffee. Furthermore, once the desired coffee has been produced it is within the pH range and compositional percentages intended for such desired coffee and, therefore, the target coffee.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-5, 8, 10-13, 16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lendrich et al as applied in paragraph 5.

If it is shown that the Lendrich et al does not prepared a coffee composition having the particular pH or concentrations called for to result in a desired coffee or target coffee, such changes would have been well within the purview of a skilled artisan. Knowing that an additive such as acid will cause a certain result, one would specifically measure the result and control the amount of additive added thereto in relation to the amount of result desired. Absent a showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time of the invention to have arrived at same through such optimization. See In re Skoner, 186 USPQ 80.

8. Claims 1-6, 8, 10-14, 16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of German 3710768, JP 11-32680, and JP 3-133368 as applied in paragraph 2.

If it is shown that none of German 3710768, JP 11-32680, and JP 3-133368 disclose or inherently disclose preparing a coffee composition having the particular pH or concentrations called for to result in a desired coffee or target coffee, such changes would have been well within the purview of a skilled artisan. Knowing that an additive

such as acid will cause a certain result, one would specifically measure the result and control the amount of additive added thereto in relation to the amount of result desired. Absent a showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time of the invention to have arrived at same through such optimization. See In re Skoner, 186 USPQ 80.

9. Claims 1-5, 7, 10-13, 15, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bach et al as applied in paragraph 3.

If it is shown that the Bach et al does not prepared a coffee composition having the particular pH or concentrations called for to result in a desired coffee or target coffee, such changes would have been well within the purview of a skilled artisan. Knowing that an additive such as acid will cause a certain result, one would specifically measure the result and control the amount of additive added thereto in relation to the amount of result desired. Absent a showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time of the invention to have arrived at same through such optimization. See In re Skoner, 186 USPQ 80.

10. Claims 1-5, 7, 10-13, 15, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Zeller et al ('131), Atkinson et al ('203), and Villiagran et al ('567) as applied in paragraph 4.

If it is shown that none of Zeller et al ('131), Atkinson et al ('203), and Villiagran et al ('567) disclose or inherently disclose preparing a coffee composition having the particular pH or concentrations called for to result in a desired coffee or target coffee, such changes would have been well within the purview of a skilled artisan. Knowing

that an additive such as acid will cause a certain result, one would specifically measure the result and control the amount of additive added thereto in relation to the amount of result desired. Absent a showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time of the invention to have arrived at same through such optimization. See In re Skoner, 186 USPQ 80.

11. Claims 9, 17, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied in any one of paragraphs 2-5 and 7-10. taken with Dar et al.

Said references are silent regarding the use of a coffee source having a blend of two or more coffee varieties. However, it is well known to combine coffee varieties to provide a coffee product having certain desired attributes as taught, for example, by Dar et al. It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated a coffee source blend as a matter of preference depending on the particular attributes desired in the final product.

Double Patenting

12. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

13. Claims 1-3, 6-11, and 14-17 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of copending Application No.

10/074851. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

14. Claims 1-21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-21 of copending Application No. 10/074850. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 4, 5, 12, and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1- 13, of copending Application No. 10/07485. Although the conflicting claims are not identical, they are not patentably distinct from each other because the the claims of copending Application No. 10/074851 are broader with regard to the range of pH values cited and it would have been obvious to one having ordinary skill in the art at the time of the invention to have narrowed said range as a matter of preference.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 11of copending Application No. 10/077325. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of copending Application No. 10/077325 employ a flavor source component and the particular flavors as called for. It would have been obvious to one having ordinary skill in the art at the time of the invention to have eliminated the use of flavors as called for in 10/077325 and used the supplemental coffee source components as defined in the instant specification as a matter of preference regarding the particular taste desired for the final product.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/074822. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of copending Application No. 10/074822 are silent regarding coffee components. It would have been obvious to one having ordinary skill in the art at the time of the invention to have employed coffee components in the broadly claims beverage as called for in 10/074822 as a matter of preference regarding the particular taste desired for the final product.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Weier
Primary Examiner
Art Unit 1761

6/24/04

Anthony Weier
June 24, 2004